

**Notice of Allowability**

Application No.

09/286,874

Examiner

Joseph T. Weitach

Applicant(s)

GRAHAM ET AL.

Art Unit

1632

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--**

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to the after final amendment filed September 8, 2003.
2. ☒ The allowed claim(s) is/are 2, 8 and 13-16.
3. ☒ The drawings filed on April 6, 1999 are accepted by the Examiner.
4. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) ☐ All b) ☐ Some\* c) ☐ None of the:
    1. ☐ Certified copies of the priority documents have been received.
    2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).
  - \* Certified copies not received: \_\_\_\_\_.
5. ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
  - (a) ☐ The translation of the foreign language provisional application has been received.
6. ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application. **THIS THREE-MONTH PERIOD IS NOT EXTENDABLE**

7. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
8. ☒ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
  - (a) ☒ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
    - 1) ☐ hereto or 2) ☐ to Paper No. 17.
  - (b) ☐ including changes required by the proposed drawing correction filed \_\_\_\_\_, which has been approved by the Examiner.
  - (c) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No. \_\_\_\_\_.

Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the margin according to 37 CFR 1.121(d).

9. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

**Attachment(s)**

- |  |   |
|--|---|
| 1 <input type="checkbox"/> Notice of References Cited (PTO-892)  | 5 <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)          |
| 2 <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                    | 6 <input checked="" type="checkbox"/> Interview Summary (PTO-413), Paper No. _____  |
| 3 <input type="checkbox"/> Information Disclosure Statements (PTO-1449 or PTO/SB/08), Paper No. _____  | 7 <input checked="" type="checkbox"/> Examiner's Amendment/Comment                  |
| 4 <input type="checkbox"/> Examiner's Comment Regarding Requirement for Deposit of Biological Material | 8 <input checked="" type="checkbox"/> Examiner's Statement of Reasons for Allowance |
|  | 9 <input type="checkbox"/> Other _____  |

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### **DETAILED ACTION**

This application filed April 6, 1999, is a continuation in part of 09/251,955, filed February 17, 1999, abandoned, which is a continuation in part of application 08/473,168, filed June 7, 1995, now US Patent 5,919,676, which is a continuation in part of application 08/250,885, filed May 31, 1994, now US Patent 6,140,087, which is a continuation in part of application 08/080,569, filed June 24, 1993, abandoned.

This application is also a continuation in part of 08/719,217, filed September 25, 1996, now US Patent 6,080,569, which is a continuation in part of 08/473,168, filed June 7, 1995, now US Patent 5,919,676, which is a continuation in part of application 08/250,885, filed May 31, 1994, now US Patent 6,140,087, which is a continuation in part of application 08/080,727, filed June 24, 1993, abandoned.

Applicants' after final amendment filed September 8, 2003 has been received and entered. The specification has been amended. Claims 1, 3, 4 and 9 have been canceled. Claims 2, 8, 13 and 15 have been amended. Claim 16 has been added. Claims 2, 5-8, 10-16 are pending. Claims 1-4, 8, 9 and 13-15 are currently under examination.

### ***Examiner's Amendment***

An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR

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1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

Authorization for this examiner's amendment was given in a telephone interview with Joseph Fischer on November 5, 2003.

The application has been amended as follows:

Cancel non-elected claims 5-7 and 10-12.

In claim 16, line 5, after the recitation of "each of which encodes" delete [functions] and insert --proteins whose functions are-- therein.

It is noted that in Applicants' reply, it is indicated that claims 5-7 and 10-12 should be canceled (page 6-Election/Restriction section), however the claim amendment listing the status of all the claims does not reflect this (see pages 3-4).

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***Reasons for Allowance***

The following is an examiner's statement of reasons for allowance:

Applicants' arguments in light of the claim amendments are found persuasive.

Specifically, while the combined teachings of the references provided in the basis of rejection made under 35 U.S.C. 103 provide all the structural limitations encompassed by the claims, none of the references by themselves or in total provide adequate motivation to combine each of the particular teachings used in the basis of the rejection. Examiner agrees that the Graham *et al.* reference does not provide the specific motivation to combine the teaching in combination with other vectors to provide different serotyped adenoviral vectors. While it is recognized that the motivation to combine the teachings of Graham *et al.* can come from other references, given all the different types of methodology used to package vectors known in the art and exemplified by the cited references, Examiner would agree that there is not particular motivation which would make the teachings of Graham *et al.* an obvious means to perform the task. The teachings of Yang *et al.*, Mack *et al.* and Kass-Eisler *et al.* provide motivation to make serotyped adenoviral vectors, there is not no specific motivation to use the vectors or methods disclosed by Graham *et al.* The amendment to newly added claim 16 has been made to more clearly indicate that while a virus may have associated functions, any virus or vector 'encodes' proteins that have these functions. Finally, the amendment to the specification to delete the claim for priority in the first line of the specification is noted. This amendment would not affect the prosecution of the instant

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application, and is consistent with the priority granted to the application set forth by the Examiner during the prosecution.

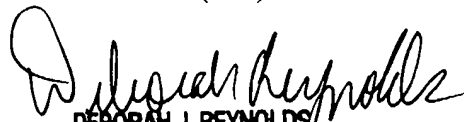
Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph Woitach whose telephone number is (703)305-3732.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Deborah Reynolds, can be reached at (703)305-4051.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group analyst Dianiece Jacobs whose telephone number is (703) 308-2141.

Joseph T. Woitach

  
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SUPERVISORY PATENT EXAMINER  
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